

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Status of Claims:

Claims 6 and 13-16 are currently being cancelled.

Claims 1, 7, 8 and 17 are currently being amended.

No claims are currently being added.

This amendment amends and cancels claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending and canceling the claims as set forth above, claims 1-5, 7-12 and 17 are now pending in this application.

Statement Regarding Information Disclosure Statement:

On page 2 of the Office Action, it states that an Information Disclosure Statement (IDS) filed on 11/30/2001 fails to comply with PTO rules because the PTO-1449 form was missing from the IDS. Applicants' representative has checked the file, and submits that no such IDS was filed on 11/30/2001. Thus, it is believed that an IDS from another application must have inadvertently been attached to this case by the PTO. In any event, that IDS is to be ignored.

Claim Rejections – Prior Art:

In the Office Action, claims 1, 3, 7, 8, 10, 14, 15, 16 and 17 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,459,499 to Tomat; claims 2, 4, 5, 9, 11 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tomat in view of U.S. Patent No. 6,069,706 to Kajita et al.; and claims 6 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tomat in view of U.S. Patent No. 5,720,014 to Ikeda et al. These rejections are traversed with respect to the presently pending claims under rejection, for at least the reasons given below.

First, please note that presently pending independent claim 1 has been amended to include the features of now-canceled claim 6; presently pending independent claim 7 has been

amended to include the features of now-canceled claim 6 (but rewritten slightly based on the differences between claim 1 and claim 7); presently pending independent claim 8 has been amended to include the features of now-canceled claim 13, and presently pending independent claim 17 has been amended to include the features of now-canceled claim 6 (but rewritten slightly based on the differences between claim 1 and claim 17).

Thus, with respect to each of the presently pending independent claims under rejection, the rejection based on the combination of Tomat and Ikeda et al. is pertinent to those claims (since the features of either claim 6 or claim 13 has been incorporated into each of the presently pending independent claims).

In its rejection of claims 6 and 13, the Office Action correctly recognizes that Tomat fails to disclose the features set forth in those claims; however, the Office Action asserts that Ikeda et al. discloses OCR processing on image data by an image reading system.

In response, Ikeda et al. merely discloses, in column 26, lines 55-60, that an information processing terminal performs an OCR process. The Office Action asserts that it would have been obvious to include information indicating whether the image display can display information other than characters, and perform OCR processing on the data if the information indicates that only characters can be displayed. Applicants strongly disagree with this assertion, and submit that Ikeda et al. certainly does not disclose or suggest such features, and that, if the PTO is to maintain this rejection, it is requested to provide a prior art reference that explicitly teaches such features, or otherwise withdraw this rejection based on an improper determination of what “would have been obvious” to do.

Note also that each of the presently pending independent claims under rejection recite that if the information indicates that the image display cannot display information other than characters, the image reading apparatus (or the step of generating the second image) performs OCR processing for the first image data and generates character information as the second image data.

For example, the Office Action asserts that “It is known in the art that terminal devices with image displays have certain levels of display capabilities.” From this assertion, the Office Action states that it would be obvious to provide such display capability information to another device, so that the other device can determine whether or not to perform OCR processing and/or other type of processing.

However, such assertions are incorrect, and amount to improper hindsight reconstruction of the presently claimed invention. There is nothing in any of the applied art of record concerning the desire to provide "display capability" information of a client terminal device to another device that is to process image data and then to provide that processed data to the client terminal. The fact that column 26, lines 55-60 of Ikeda et al. discloses that a facsimile apparatus provides resolution information and coding information to an information processing terminal is not particularly relevant to the features recited in the presently pending independent claims, since it is the information provided from the information processing terminal to the facsimile apparatus that is pertinent as to the present claims, and not the information provided from the facsimile apparatus to the information processing terminal.

Accordingly, such features are not taught or suggested by either Tomat or by Ikeda et al., alone or in combination.

Therefore, each of the presently pending independent claims under rejection is patentable over the cited art of record. Each of the presently pending dependent claims under rejection is patentable due to the specific features recited in those claims, as well as for the reasons given above for their respective base claim.

35 U.S.C. § 101 Rejection of Claims 14-16:

In the Office Action, claims 14-16 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Due to the cancellation of claims 14-16, this rejection is now moot.

Conclusion:

Since all of the issues raised in the Office Action have been addressed in this Amendment and Reply, Applicants believe that the present application is now in condition for allowance, and an early indication of allowance is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a

check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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